

REMARKS

New independent claims 14 and 15 are added via the foregoing amendments; hence, claims 1-15 are presently pending in this application. Applicant respectfully submits that the amendments to claims 1-13 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1-13 were not made for reasons of patentability.

Priority

Applicant thanks the Examiner for initialing the references listed on Form PTO/SB/08 A & B filed with Information Disclosure Statement on January 1, 2006. Applicant also thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received.

Rejections Under 35 U.S.C. §103(a)

Claims 1-8 and 12-13

Claims 1-8 and 12-13 are rejected (as best the Applicant can understand) under 35 U.S.C. §103(a) as being unpatentable over JP H11-66273 (hereinafter "JP '273"). Applicant respectfully traverses the rejection.

First, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for unpatentability. "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." M.P.E.P. 706.02(j). "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." *Id.* Here, for each assertion that JP '273 teaches a feature of the claimed invention, the Examiner cites to "p.1 lines 15-18" of Applicant's specification. Page 1, lines 15-18 of Applicant's specification does not teach or suggest the features for which the Examiner cites the text. As best Applicant understands the Examiner's rejection, the features are allegedly taught in JP '273. Accordingly, the Examiner is respectfully requested to provide references in the prior art, or to withdraw his rejections.

The Examiner seems to argue that although the primary reference, JP '273, does not teach all of the features of the invention, the missing features are old and well known in the art; therefore, claims 1, 3, 5 and 7 are obvious under 35 U.S.C. §103(a). "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *See* M.P.E.P. 2143; *see also*

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Specifically, the Examiner alleges that “[e]xamining a document and/or identification from both sides, either via a manual or an automated system, is old and well known in the art of authentication and verification” (p. 4), “biometric data, as a facial image, is a standard and/or conventional identifier located on an identification card” (p. 7), and “transmit[ing] data obtained to a remote server for identification purposes...is well old and well known” (p. 7). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. See In re Lalu, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984). Furthermore, **an Examiner may not rely on official or judicial notice at the exact point where patentable novelty is argued**, but must come forward with pertinent prior art. See Ex parte Cady, 148 USPQ 162 (Pat. Off. Bd. App. and Inter. 1965). Accordingly, the Examiner is respectfully requested to provide reference or withdraw the rejections.

Moreover, merely asserting certain features of the claimed invention are old and well known is not sufficient to prove obviousness without showing a proper motivation to combine the elements to produce the claimed invention. Most, if not all, inventions arise from a combination of old elements. In re Kotzab, 55 USPQ2d at 1316 (citing In re Rouffet, 149 F.3d 1350,

1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. In re Kotzab, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). The Examiner's assertions that one of ordinary skill in the art would have been motivated to produce the claimed combinations because: the elements are "old and well known" (p.4), "the inventor desired such" (p. 5), something is "a standard and/or conventional procedure in such a transaction" (p.7), or "standard and/or conventional" (p. 7); are not taught or suggested by the prior art and therefore fail to meet the burden of proof necessary to prove the obviousness of a combination.

The Examiner's assertion that certain features of the claimed invention are obvious because they represent "mere duplication" (second camera and additional light in claims 3-8) is also improper. The Examiner cites St. Regis Paper Co. v. Bemis Co., 193 USPQ 8 (7th Cir. 1997) and In re Harz, 124 USPQ 378 (CCPA 1960) in support of this assertion; however, Applicant respectfully submits the Examiner is misapplying the principles set forth in these cases. St. Regis Paper Co. involved the "Lokey" bag patent, for a bag entirely comprised of old

elements and combinations, but which included “multiple layers” (i.e., a second bag sewed inside to provide support). *See St. Regis Paper Co.*, 193 USPQ at 10 and 11. The Court of Appeals for the Seventh Circuit explained that the Lokey bag was only entitled to a patent “if the fusion of the old elements...created a synergistic combination.” The Court of Appeals held that multiple layers for strengthening a bag was not synergistic and so the Lokey bag was not entitled to protection. *Id.* at 16. It was the combination that the Court looked at, not the elements themselves in determining whether the elements were old and well known in the art.

In re Harz, which the Examiner also relies on, stands merely for the proposition that “a plurality” of an element ‘A’ does not serve to distinguish an invention from prior art that teaches a single element ‘A’, unless it produces some new result. *See In re Harz*, 124 USPQ 385 and 386 (“The only distinction to be found is in the recitation in claim 1 of a plurality of ribs...whereas Gardner shows only a single rib...it is well settled mere duplication of parts has no patentable significance unless a new and unexpected result is produced”). As is explained on page 2 of Applicant’s specification, “the conventional devices that judge the authenticity of a driver’s license only by the image data of the obverse may judge an authentic back-watermarked type driver’s license to be false by mistake.” Therefore, it is “an object of the present invention to judge the authenticity of a driver’s license automatically no matter whether it is a face-watermarked type driver’s license or a back-watermarked type one.”

From the tenor of the grounds of rejection, it would appear that the Examiner has decided, even though no anticipatory or particularly relevant reference has been found, that the present invention is too simple to be deserving of a patent. As a result, the Examiner has formulated grounds of rejection which, at first blush, appear to be based on actual prior art disclosure, but instead are based on an impermissible hindsight rationale. *See In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicant respectfully submits that claims 1-8 and 12-13 would not have been obvious under 35 U.S.C. §103(a) because JP '273 does not teach all of the features of the claims 1-8 and 12-13, nor would one of ordinary skill in the art have been motivated to modify JP '273 to include the missing features because there are no teachings nor suggestions to do so. Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-8 and 12-13.

Claim 2, 4, 6, 8 an 10

In addition to the foregoing remarks, Applicant respectfully submits that, with regard to claim 2, it is clear that JP '273 does not teach or suggest:

a driver's license shooting controller which outputs the shooting instruction to the driver's license shooting means at the beginning of the authenticity judging operation, and outputs the re-shooting instruction to the driver's license shooting means when the watermark shot from one side is not recognized as a regular watermark

as required by (amended) claim 2. Indeed, the Examiner does not provide any substantive discussion why this feature would have been obvious. Applicant respectfully submits that claim 2

would not have been obvious under 35 U.S.C. §103(a) because the cited prior art does not disclose each every feature of claim 2, nor does the prior art provide a teaching or suggestion why the additional features in claim 2 would have been obvious. Applicant respectfully submits that claims 4, 6 and 8 are patentable at least by virtue of their dependency on claim 2.

Claims 9-11

Claims 9-11 are rejected (as best Applicant understands it) under 35 U.S.C. §103(a) as being unpatentable over JP '273 in view of Soltesz (WO 99/30,267). Applicant respectfully traverses the rejection.

With regard to claims 9-11, Applicant respectfully submits that the Examiner has clearly failed to make a *prima facie* case for unpatentability. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.**" See M.P.E.P. 2143; *see also Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Here, the Examiner seems to be confusing breadth of the prior art with the features and limitations the prior art actually discloses. With regard to claim 9, the Examiner asserts that the

claimed “image camera for shooting a facial portrait of a user” reads on a “biometric capture device” disclosed in the abstract of Soltesz. It is quite clear, however, that Soltesz does not teach or suggest an “image camera for shooting a facial portrait of a user”. The Examiner further asserts that the claimed “face image collator for verifying identify of the user” reads on a controller for comparing biometrics data disclosed in Soltesz. Applicant respectfully submits that it is quite clear that the abstract of Soltesz does not teach or suggest “a face image collator” as required by claim 9.

Applicant respectfully submits that claim 9 would not have been obvious under 35 U.S.C. §103(a) because, JP ‘273 and Soltesz, alone or in combination, do not teach or suggest all of the features of the claim. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 9. Claim 10 is similar to claim 9 and is patentable by the same reasoning. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of claim 10.

Regarding claim 11, the Examiner concedes that that JP ‘273 and Soltesz, alone or in combination, do not teach “a transmitting section for transmitting image data of the facial portrait obtained by the image camera to a server”, the Examiner instead asserts that:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified JP ‘273 and Soltesz to allow for any computer system architecture that the inventor desired such as performance of identification processes on site or via transmission for processing at a remote location.

As with claims 1-8 and 12-13, the Examiner has failed to make a *prima facie* case for unpatentability under 35 U.S.C. §103(a) with regard to claim 11. To make a *prima facie* case, the Examiner is required to show, among other things, “some suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the prior art.” M.P.E.P. 2143. As explained *supra*, an inventor’s “desire”, or the fact that a feature might be well known in the art, is not a substantive discussion sufficient to meet the Examiner’s burden to show motivation. Therefore, the only motivation the Examiner is left with is impermissible hindsight. See In re Laskowski, 10 USPQ2d 1397 (Fed. Cir. 1989). Accordingly, the Examiner is respectfully requested to provide a proper teaching or motivation in the prior art, or withdraw the rejection.

Conclusion

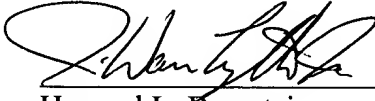
In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

Amendment Under 37 C.F.R. §1.111
U.S. Application No. 09/899,075

Art Unit 3693
Attorney Docket No. Q65358

The USPTO is directed and authorized to charge all required fees (with the exception of the Issue/Publication Fees) to our Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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